

PATENT**Application # 09/867,803****Attorney Docket # 1005-006****REMARKS**

The Examiner is respectfully thanked for the thoughtful consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

The Examiner is also thanked for determining each of claims 2 and 7-8 allowable. The Examiner is further thanked for indicating that each of claims 3 and 4 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-8 are now pending in this application. Each of claims 1-8 are in independent form.

The Anticipation Rejections

Each of claims 1 and 5-6 was rejected as anticipated under 35 U.S.C. 102(b). In support of the rejection, McLennan ("Statistics - A Powerful Edge!", 1998) was cited. These rejections are respectfully traversed.

In support of these rejections, the Office Action improperly references a large portion of McLennan, namely pages 37-45. Thereby, the rejections fail to meet the requirements of 37 C.F.R. 1.104(c)(2), which states "when a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on **must** be designated as nearly as practicable." See also, MPEP 707.07(d), "where a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection fully and clearly stated" and MPEP 706.02(i), "**the particular part of the reference relied upon to support the rejection should be identified.**" Designation of the particular part of McLennan relied upon to support the rejections is respectfully requested.

McLennan fails to establish a prima facie case of anticipation. See MPEP 2131. To anticipate expressly, the "invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim". *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter "with sufficient clarity and detail to establish that the subject matter existed in the prior art

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and that its existence was recognized by persons of ordinary skill in the field of the invention". *Crown Operations Int'l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) ("A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.") The USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

As explained at MPEP 2111.01, the words of a claim must be given their plain meaning unless they are defined in the specification. Further, in a recent *en banc* ruling, the Federal Circuit held that "[e]ven when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents." *Phillips v. AWH Corp.*, No. 03-1269 (Fed. Cir. 2005) (*en banc*) (citing *Novartis Pharms. Corp. v. Abbott Labs.*, 375 F.3d 1328, 1334-35 (Fed. Cir. 2004). "Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." *Phillips v. AWH Corp.*, No. 03-1269 (Fed. Cir. 2005) (*en banc*).

Claims 1, 5, and 6 recite "obtaining a data set containing no more than one proxy value for each of a plurality of variables". McLennan does not teach expressly or inherently "obtaining a data set containing no more than one proxy value for each of a plurality of variables", a "proxy value", or "a plurality of variables". Instead, to the extent that the Office Action interprets "battery life" as a "variable", McLennan at most describes only a single variable.

Further, McLennan does not describe a "no more than one proxy value" as that phrase is implicitly defined in the specification at page 55, lines 4-17. Instead, to the extent that the McLennan's "value" for battery life is interpreted by the Office Action as equivalent to a "proxy value" (an interpretation with which Applicant respectfully disagrees), McLennan describes "more than one proxy value" rather than "no more than one proxy value".

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Also, claims 1, 5, and 6 recite, yet McLennen does not teach or suggest, expressly or inherently, "calculating a percent of proxy values for the plurality of variables that equals a mode of that observation's corresponding cluster's proxy values for the corresponding variables", a "plurality of variables", or "a mode of" a single "cluster's proxy values".

Instead, to the extent that the Office Action interprets McLennen's "a most frequently observed value" as a "mode", that "mode" is for all the "battery life" "values" rather than being "a mode of" a single "cluster's proxy values".

Accordingly, it is respectfully submitted that the rejection of claims 1, 5, and 6 is unsupported by McLennen and should be withdrawn.

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter: "none of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims. Namely, claims 1, 5, and 6 are allowable because none of the references of record alone or in combination disclose or suggest 'obtaining a data set containing no more than one proxy value for each of a plurality of variables' or 'calculating a percent of proxy values for the plurality of variables that equals a mode of that observation's corresponding cluster's proxy values for the corresponding variables'".

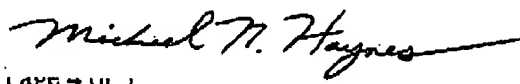
CONCLUSION

It is respectfully submitted that, in view of the foregoing remarks, the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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